REMARKS

Claims 20-32 are pending in this application. A complete listing of these claims, including withdrawn claims 27-32, is provided in the Response to Restriction Requirement, filed October 27, 2005.

Priority Claim

The priority claim on page 2 of the Office Action is incorrect. The Supplemental Preliminary Amendment filed June 2, 2005 provides the correct priority claim. In particular, the first paragraph of the specification (and immediately preceding section heading) states:

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a divisional of application Serial No. 10/199,481, filed July 22, 2004, now U.S. Patent No. 6,846,954, which is a divisional of application Serial No. 08/451,090, filed May 25, 1995, now U.S. Patent No. 6,455,581, which is a divisional of application Serial No. 08/204,827, filed March 2, 1994, now U.S. Patent No. 6,060,476, which is a continuation-in-part of International Application PCT/US93/07814, filed August 24, 1993, which is a continuation-in-part of application Serial No. 07/934,984, filed August 25, 1992, now abandoned.

The above priority claim is consistent with the Application Data Sheet filed March 30, 2004 and also with the Filing Receipt mailed June 20, 2004.

The Rejection of Claim 25 under 35 U.S.C. § 101

Claim 25 has been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 15 of U.S. Patent No. 5,968,942 (the '942 patent). Applicants respectfully traverse this rejection.

It is well established that claims of the "same invention" under 35 U.S.C. § 101 are directed to

> . . .identical subject matter. . .[P]robably the only objective test, for "same invention" is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. . .

In re Vogel, 422 F.2d 438, 164 (CCPA 1970). The objective test announced in *In re Vogel*, termed the "cross-readability" test, has been reaffirmed by the Federal Circuit as being the method of determining whether "same invention" type double patenting exists. *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 223 USPQ 584 (Fed. Cir. 1984).

Claim 15 of the '942 patent embraces 41 compounds, whereas pending claim 25 embraces 35 compounds. At least 6 compounds in claim 15 of the '942 patent are therefore not recited in pending claim 25. It is readily apparent that claim 15 of the '942 patent could be literally infringed without literally infringing pending claim 25, by virtue of the at least 6 non-overlapping compounds. These two claims do not cross-read and are therefore not directed to the same invention for purposes of 35 U.S.C. § 101.

Reconsideration and withdrawal of this rejection are respectfully requested.

The Nonstatutory Double Patenting Rejection

Pending claims 20-26 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-16 of U.S. Patent No. 5,968,942.

In the interest of expediting prosecution, Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) over the above-cited U.S. Patent No. 5,968,942, as well as U.S. Patent Nos. 6,924,286; 6,500,832; 6,472,407; 6,455,581; 6,417,387; 6,335,460; 6,248,775; 6,060,476; 6,046,190; and 5,843,946.

Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

In view of the above remarks, as well as the Terminal Disclaimer under 37 C.F.R. § 1.321(c), filed herewith, all pending claims of this application are believed to be in condition for allowance. Acknowledgement of the same is respectfully requested.

This response is believed to completely address all of the substantive issues raised in the Office Action dated January 6, 2006.

Respectfully submitted,

Date: April 6, 2006

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